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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,370	09/30/2003	Kevin Maus	703060	4053

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LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

NOTIFICATION DATE	DELIVERY MODE
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08/19/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/676,370	<b>Applicant(s)</b> MAUS, KEVIN	
	<b>Examiner</b> GREGORY JOHNSON	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This communication is responsive to Applicant's election without traverse of Group I (claims 1-31) in the reply filed on April 16, 2009 is acknowledged.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 1, in essence, recites two limitations. The first involving a server receiving a request from a producer. The second involving the producer receiving a response to said request from a broker. It has been interpreted that the server and broker are separate entities. The invention of claim 1 omits essential information, such as how did the broker know about the producer's request, which the broker then responded to. For examination purposes, the limitations have been interpreted as:

- receiving at a server a request from an insurance producer, operating in a first jurisdiction, to place an insurance policy of a specific type in the first jurisdiction; and
- transmitting to the producer, in response to the request, authorization from **the server** in the first jurisdiction to produce the insurance policy.

Appropriate action is required to claim 1 to particularly pointing out and **distinctly claim the subject matter** which the applicant regards as his invention

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Douglas McLeod, "Web site connects insurers, agents", (hereinafter McLeod).

As to claim 1, McLeod discloses a computer implemented method comprising:

- receiving at a server a request from an insurance producer, operating in a first jurisdiction, to place an insurance policy of a specific type in the first jurisdiction (pg. 2; via Internet Wholesale Insurance Exchange [iwix.net]; and agents will be able to access the site and submit specialty risks);
- transmitting to the producer, in response to the request, authorization from a broker who is licensed in the first jurisdiction to produce the insurance policy (pg. 2; via after iwix.net identifies the insurers willing to write a particular risk, an agent can select the companies he or she would like quotes from).

As to claims 2-3, McLeod discloses the following limitations:

- further comprising, in response to the request at the server, automatically identifying one or more brokers who are licensed to place the specific type

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of insurance policy in the first jurisdiction (pg. 2; via after iwix.net identifies the insurers willing to write a particular risk, an agent can select the companies he or she would like quotes from); and

- wherein the insurance producer is not licensed in the first jurisdiction to broker insurance policies of the specific type (pg. 2).

As to claims 8-31, McLeod discloses the following limitations:

- wherein the insurance policy comprises a surplus lines insurance policy (pg. 2).
- wherein the surplus lines insurance policy includes a property and casualty insurance policy (pg. 1).
- wherein identifying the broker comprises providing a database containing information sufficient to identify brokers who are licensed in the first jurisdiction to place policies of the specific type (pgs. 1-2).
- wherein the database identifies brokers who have surplus lines broker's licenses in the first jurisdiction (pgs. 1-2).
- wherein the database identifies brokers who have surplus lines broker's licenses in a second jurisdiction (pgs. 1-2).
- further comprising providing a database containing information describing legal requirements for placing policies of the specific type in the first jurisdiction (pgs. 1-2).

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- wherein the database contains information describing legal requirements for placing policies of the specific type in a second jurisdiction (pgs. 1-2).
- further comprising, at the broker, satisfying the legal requirements described in the database (pgs. 1-2).
- further comprising determining whether the insurance policy is exempt from a legal requirement described in the database (pgs. 1-2).
- wherein determining whether the insurance policy is exempt from a legal requirement comprises determining whether the specific type of insurance policy is listed on an export list that specifies the types of insurance that are exempt from a diligent search requirement (pgs. 1-2).
- determining whether the insurance policy is exempt from a legal requirement comprises determining whether an insured entity qualifies for an industrial insured exception (pgs. 1-2).
- further comprising, generating an affidavit or declaration to be signed by the producer or a representative of the producer, said affidavit or declaration being generated based on the legal requirements described in the database.
- wherein the affidavit or declaration contains a statement specifying that the broker was not able to find an insurance company licensed to provide insurance policies of the specific type in the first jurisdiction (pgs. 1-2).

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- further comprising generating the insurance policy and relevant documents according to regulatory requirements of the first jurisdiction related to insurance policies of the specific type (pgs. 1-2).
- wherein the relevant documents comprise an affidavit or declaration that contains a statement specifying that the broker was not able to find an insurance company licensed to provide insurance policies of the specific type in the first jurisdiction to underwrite the insurance policy (pgs. 1-2).
- wherein the relevant documents comprise a tax form for paying tax related to the insurance policy (pgs. 1-2).
- further comprising rating the insurance policy based on a set of guidelines (pgs. 1-2).
- further comprising notifying an underwriter who underwrites the insurance policy when the insurance policy does not satisfy the set of guidelines (pgs. 1-2).
- further comprising providing a graphical user interface (GUI) to the underwriter to allow the underwriter to rate the insurance policy when the insurance policy does not satisfy the set of guidelines (pgs. 1-2).
- further comprising providing a GUI to the broker to allow the broker to modify the insurance policy (pgs. 1-2).
- further comprising placing the insurance policy with an insurance company that is not licensed to underwrite insurance policies in the first jurisdiction (pgs. 1-2).

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- further comprising sending a message to an underwriter of the insurance policy indicating that the insurance policy needs to be renewed (pgs. 1-2).
- further comprising sending an approval to the producer indicating that a renewal of the insurance policy has been approved (pgs. 1-2).
- further comprising registering an insured entity of the insurance policy with a reservation system to notify producers or brokers that are affiliated with the producer who produced the insurance policy that the insured entity has already been contacted regarding the insurance policy (pgs. 1-2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, in view of Official Notice.



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As to claims 4 and 6-7, McLeod discloses that agents access iwic.net over the Internet to submit specialty risks. McLeod does not explicitly disclose the following limitations:

- providing a graphical user interface (GUI) to the insurance producer to allow the insurance producer to enter the request;
- wherein the GUI is provided to the producer over the Internet; and
- wherein the GUI is configured to be displayed by an Internet browser.

However, Official Notice is taken that the use of a graphical user interface (GUI) is well known for Internet browser such as Microsoft™ Internet Explores. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations for the motivation to provide a method accessing a web site via the Internet.

As to claim 5, McLeod discloses the following limitation:

- wherein the GUI allows the insurance producer to enter information related to an insured entity of the insurance policy (pg. 2; via submit for information for specialty risk quotation [e.g. directors and officers liability, kidnap/ransom]).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON  
Examiner, Art Unit 3691